

ESTTA Tracking number: **ESTTA677307**

Filing date: **06/10/2015**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

Opposer Information

Name	Instagram, LLC
Granted to Date of previous extension	06/10/2015
Address	1601 Willow Road Menlo Park, CA 94025 UNITED STATES

Attorney information	Annie L. Albertson KILPATRICK TOWNSEND & STOCKTON LLP 9720 Wilshire Blvd. Penthouse Suite Beverly Hills, CA 90212 UNITED STATES aalbertson@kilpatricktownsend.com, lmcfarland@kilpatricktownsend.com, mmm@kilpatricktownsend.com, tmadmin@kilpatricktownsend.com
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Applicant Information

Application No	86397280	Publication date	02/10/2015
Opposition Filing Date	06/10/2015	Opposition Period Ends	06/10/2015
Applicant	Software Success LLC 4804 granite dr ste f3261 rocklin, CA 956772857 UNITED STATES		

Goods/Services Affected by Opposition

Class 009. First Use: 2014/09/01 First Use In Commerce: 2014/09/17
All goods and services in the class are opposed, namely: Computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications

Grounds for Opposition

Deceptiveness	Trademark Act section 2(a)
False suggestion of a connection	Trademark Act section 2(a)
Priority and likelihood of confusion	Trademark Act section 2(d)
Dilution	Trademark Act section 43(c)


Marks Cited by Opposer as Basis for Opposition

U.S. Registration No.	4146057	Application Date	09/19/2011
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Registration Date	05/22/2012	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Downloadable computer software for modifying the appearance and enabling transmission of photographs		

U.S. Registration No.	4170675	Application Date	09/19/2011
Registration Date	07/10/2012	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 042. First use: First Use: 2010/10/06 First Use In Commerce: 2010/10/06 Providing a web site that gives users the ability to upload photographs; technical support services, namely, providing help desk services in the field of computer software, namely, providing users with instructions and advice on the use of downloadable computer software, provided online and via e-mail; computer services, namely, providing an interactive website featuring technology that allows users to manage their online photograph and social networking accounts		

U.S. Application No.	85866573	Application Date	03/04/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		

Design Mark	
Description of Mark	The mark consists of the word "INSTAGRAM" written in script writing.
Goods/Services	<p>Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable computer software for modifying the appearance and enabling transmission of photographs; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software for use as an application programming interface (API); computer software in the nature of an application programming interface (API) for computer software which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks</p> <p>Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunications services, namely, electronic transmission of data, messages, graphics, images and information; peer-to-peer photo sharing services, namely, electronic transmission of digital photofiles among internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online communications links which transfer web site users to other local and global web pages; providing online chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, and images; telecommunications services, namely, electronic transmission of photos and videos</p> <p>Class 041. First use: First Use: 0 First Use In Commerce: 0 Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing services, namely, publishing of electronic publications for others</p> <p>Class 042. First use: First Use: 0 First Use In Commerce: 0 Providing a web site that gives users the ability to upload photographs; computer services, namely, providing an interactive web site featuring technology that allows users to manage their online photograph and social networking accounts; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of photographs; file sharing services, namely, providing a web site featuring technology enabling users to upload and download electronic files; hosting on-line web facilities for others for managing and sharing on-line content; providing information from searchable indexes and databases of information; providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting online web facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the upload-</p>

	<p>ing, downloading, streaming, posting, displaying, blogging, linking, sharing or otherwise providing electronic media or information over communication networks; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple web sites; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple web sites; providing information on topics of general interest from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or user-specified information, personal profiles, audio, video, photographic images, text, graphics and data</p> <p>Class 045. First use: First Use: 0 First Use In Commerce: 0</p> <p>Internet based social introduction, networking and dating services; providing on-line computer databases in the fields of social networking, social introduction and dating</p>
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U.S. Application No.	85965167	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	<p>Class 042. First use: First Use: 0 First Use In Commerce: 0</p> <p>Providing a web site that gives users the ability to upload images, videos and audio-visual content; providing use of online temporary non-downloadable software for modifying the appearance and enabling transmission of images and audiovisual and video content; file sharing services, namely, providing a website featuring technology enabling users to upload and download electronic files; hosting on-line web facilities as websites and mobile sites for others for managing and sharing on-line content; providing information from searchable indexes and databases of information; providing search engines for obtaining data via communications networks; computer services, namely, creating virtual communities for registered users to participate in discussions and engage in social, business and community networking; computer services, namely, hosting electronic facilities for others for organizing and conducting meetings, events and interactive discussions via communication networks; application service provider (ASP) services, namely, hosting computer software applications of others; application service provider (ASP) featuring software to enable or facilitate the uploading, downloading, streaming, posting, displaying, blogging, linking, sharing</p>		

	or otherwise providing electronic media or information over communication networks; providing an online network service that enables users to transfer personal identity data to and share personal identity data with and among multiple websites; providing a web site featuring technology that enables online users to create personal profiles featuring social networking information and to transfer and share such information among multiple websites; providing information from searchable indexes and databases of information, including text, electronic documents, databases, graphics and audio visual information, on computer and communication networks namely, provision of search engines for the Internet; providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; computer services in the nature of customized web pages featuring user-defined or specified information in the nature of personal profiles, audio, video, photographic images, text, graphics and data
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U.S. Application No.	85965169	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 041. First use: First Use: 0 First Use In Commerce: 0 Providing computer, electronic and online databases in the field of entertainment; publication of electronic journals and web logs featuring user generated or specified content; publishing of electronic publications for others		

U.S. Application No.	85965171	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			

Description of Mark	NONE
Goods/Services	Class 045. First use: First Use: 0 First Use In Commerce: 0 Internet based Social introduction, networking and dating services; providing information in the form of databases featuring information in the fields of social networking, social introduction and dating

U.S. Application No.	85965174	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
Design Mark	

Description of Mark	NONE
Goods/Services	Class 009. First use: First Use: 0 First Use In Commerce: 0 Downloadable computer software for modifying the appearance and enabling transmission of images, audio-visual and videocontent; computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information; computer software for use as an application programming interface (API); computer software in the nature of an application programming interface (API) which facilitates online services for social networking, building social networking applications and for allowing data retrieval, upload, download, access and management; computer software to enable uploading, downloading, accessing, posting, displaying, tagging, blogging, streaming, linking, sharing or otherwise providing electronic media or information via computer and communication networks

U.S. Application No.	85965177	Application Date	06/20/2013
Registration Date	NONE	Foreign Priority Date	NONE

Word Mark	INSTAGRAM
Design Mark	

Description of Mark	NONE
Goods/Services	Class 038. First use: First Use: 0 First Use In Commerce: 0 Telecommunications services, namely, electronic transmission of data, messages, graphics, images, videos and information; peer-to-peer photo and video sharing services, namely, electronic transmission of digital photos, video and audio-visual files among internet users; providing access to computer, electronic and online databases; providing online forums for communication, namely, transmission on topics of general interest; providing online communications links which transfer web site users to other local and global web pages; providing on-line chat rooms and electronic bulletin boards for transmission of messages among users in the field of general interest; broadcasting services over computer or other communication networks, namely, uploading, posting, displaying, tagging, and electronically transmitting data, information, messages, graphics, videos, and images

U.S. Application No.	86100072	Application Date	10/24/2013
Registration Date	NONE	Foreign Priority Date	NONE
Word Mark	INSTAGRAM		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 035. First use: First Use: 2013/08/00 First Use In Commerce: 2013/11/01 Marketing, advertising and promotion services; dissemination of advertising for others via computer and communication networks; marketing and advertising consultation services; promoting the goods and services of others via computer and communication networks; market research services; provision of market research information Class 038. First use: First Use: 2013/08/00 First Use In Commerce: 2013/11/01 Telecommunication services, namely, transmission of advertisements and media advertising communications via computer and communication networks		

Attachments	85426267#TMSN.png(bytes) 85426271#TMSN.png(bytes) 85866573#TMSN.png(bytes) 85965167#TMSN.png(bytes) 85965169#TMSN.png(bytes) 85965171#TMSN.png(bytes) 85965174#TMSN.png(bytes) 85965177#TMSN.png(bytes) 86100072#TMSN.png(bytes) 67388306_1.pdf(32824 bytes)
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Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Annie L. Albertson/
Name	Annie L. Albertson
Date	06/10/2015

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

In re Application No. 86/397,280

Filed: September 17, 2014

Published: February 10, 2015, in the *Official Gazette*

For: **SHOWMEGRAM**

INSTAGRAM, LLC,

Opposer,

vs.

SOFTWARE SUCCESS LLC,

Applicant.

Opposition No. _____

NOTICE OF OPPOSITION

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

P.O. Box 1451

Alexandria, Virginia 22313-1451

Sir or Madam:

Instagram, LLC (“Opposer” or “Instagram”) believes it will be damaged by the registration of the mark SHOWMEGRAM covered by Application Serial No. 86/397,280, filed on September 17, 2014, by Software Success LLC (“Applicant”), and hereby opposes such registration.

1. Instagram is a Delaware limited liability company with its headquarters and principal place of business at 1601 Willow Road, Menlo Park, California 94025. Applicant is, upon information and belief, an Indiana limited liability company located at 4804 Granite Drive, Suite F3261, Rocklin, California 95677. This Notice of Opposition has been timely filed. As grounds of opposition, Instagram alleges as follows.

2. As illustrated in the Official Gazette dated February 10, 2015, Applicant seeks to register the SHOWMEGRAM mark that is the subject of Application Serial No. 86/397,280, in International Class 9 for “Computer hardware and computer software programs for the integration of text, audio, graphics, still images and moving pictures into an interactive delivery for multimedia applications.” The application claims a first use date of September 17, 2014.

3. Since the launch of its photo sharing and social networking service and software application in October 2010, Instagram has continuously used the trademark INSTAGRAM in interstate commerce in the United States in connection with its goods and services. Reflecting its trademark rights, Instagram owns the following U.S. registrations and applications for its INSTAGRAM mark:

<u>Trademark</u>	<u>Reg. or App. No.</u>	<u>Reg. or App. Date</u>	<u>First Use Date</u>
INSTAGRAM	4146057	5/22/2012	10/6/2010
INSTAGRAM	4170675	7/10/2012	10/6/2010
INSTAGRAM (stylized)	85866573	3/4/2013	N/A
INSTAGRAM	85965167	6/20/2013	N/A
INSTAGRAM	85965169	6/20/2013	N/A
INSTAGRAM	85965171	6/20/2013	N/A
INSTAGRAM	85965174	6/20/2013	N/A
INSTAGRAM	85965177	6/20/2013	N/A
INSTAGRAM	86100072	10/24/2013	11/1/2013

These registrations and applications cover a variety of goods and services, including but not limited to the following:

- Downloadable computer software for modifying the appearance and enabling transmission of photographs;

- Computer software for the collection, editing, organizing, modifying, transmission, storage and sharing of data and information;
- Telecommunications services, namely electronic transmission of data, messages, graphics, images and information;
- Computer services, namely providing an interactive website featuring technology that allows users to manage their online photograph and social networking accounts;
- Online software for modifying the appearance and enabling transmission of photographs;
- Providing temporary use of non-downloadable software applications for social networking, creating a virtual community, and transmission of audio, video, photographic images, text, graphics and data; and,
- Social introduction, networking and dating services.

Instagram's registrations and applications for its INSTAGRAM trademark are incorporated herein by reference.

4. In addition, Instagram owns common law rights in the INSTAGRAM mark in connection with various other goods and services, including as identified in Instagram's pending U.S. trademark applications. All of Instagram's marks that feature the term INSTAGRAM are referred to herein as the "INSTAGRAM Marks."

5. The INSTAGRAM Marks are highly distinctive with regard to all of Instagram's goods and services in connection with which the marks are used, including photo and video sharing services and software.

6. Instagram's INSTAGRAM Marks are undisputedly prior to Applicant's application, which claims a first use date of September 17, 2014.

7. Applicant's SHOWMEGRAM mark creates a similar commercial impression as the INSTAGRAM Marks.

8. Applicant's goods claimed in its application are related to the goods and services offered by Instagram in connection with its INSTAGRAM Marks.

9. Applicant's mark is deceptively similar to the INSTAGRAM Marks so as to cause confusion, or to cause mistake or to deceive the public as to the origin of Applicant's goods and services offered under the mark. Specifically, registration of Applicant's mark will lead the public to conclude, incorrectly, that Applicant is or has been affiliated or connected with Instagram, and/or that Applicant's goods provided under the mark are or have been, authorized, sponsored, endorsed, or licensed by Instagram. Issuance of any registration to Applicant for the proposed mark will result in damage to Instagram and the public. Therefore, registration of Applicant's mark is prohibited by 15 U.S.C. §§ 1052(a) and 1052(d).

10. Moreover, through Instagram's widespread use of the INSTAGRAM Marks, extensive and continuous media coverage, the high degree of consumer recognition of the INSTAGRAM Marks, Instagram's enormous and loyal user base, its multiple trademark registrations and pending applications, and other factors, the INSTAGRAM Marks are strong, enjoy widespread recognition among consumers, and have become famous within the meaning of Section 43(a) of the United States Trademark Act, 15 U.S.C. § 1125(c).

11. Applicant's mark has caused or is likely to cause dilution of the distinctive quality of the INSTAGRAM Marks and/or harm the reputation of the INSTAGRAM Marks in violation of 15 U.S.C. § 1125(c), to the harm and damage of Instagram and the public.

12. The INSTAGRAM Marks were famous before Applicant filed the application at issue and before Applicant began its use of the proposed mark.

13. Therefore, registration of Applicant's mark should be refused under 15 U.S.C. §§ 1052 and 1063(a).

14. Registration of Applicant's mark would constitute *prima facie* evidence of the validity of such registration, Applicant's ownership of the mark, and Applicant's exclusive right

to use the mark pursuant to the provisions of 15 U.S.C. § 1057(b). Such registration would be a source of damage and injury to Instagram and the public, and would be contrary to the principles of registration set out in 15 U.S.C. §§ 1051 *et seq.*

WHEREFORE, Instagram prays that this Opposition be sustained, and that registration to Applicant for the mark covered by Application Serial No. 86/397,280, be refused.

Please charge any necessary fee regarding this Opposition to the Deposit Account of Kilpatrick Townsend and Stockton LLP, No. 20-1430, and credit any overpayment to such deposit account. Please direct all notices, pleadings and process regarding this matter to:

Annie L. Albertson, Esq.
Kilpatrick Townsend & Stockton LLP
9720 Wilshire Boulevard, PH Suite
Beverly Hills, CA 90212
Telephone: (310) 248-3830
Facsimile: (310) 860-0363
Email: aalbertson@kilpatricktownsend.com

Respectfully submitted,

KILPATRICK TOWNSEND & STOCKTON LLP

Dated: June 10, 2015

By: /s/ Annie L. Albertson
Larry W. McFarland
Annie L. Albertson
Attorneys for Opposer Instagram, LLC

Kilpatrick Townsend & Stockton LLP
9720 Wilshire Boulevard, PH Suite
Beverly Hills, CA 90212
Telephone: (310) 248-3830
Facsimile: (310) 860-0363

CERTIFICATE OF SERVICE

I hereby certify that on June 10, 2015, I served the foregoing **NOTICE OF OPPOSITION** on the parties in said action by depositing a true copy thereof with the United States Postal Service as first class mail, postage prepaid, at Los Angeles, California, enclosed in a sealed envelope addressed as follows:

Software Success LLC
4804 Granite Drive
Suite F3261
Rocklin, CA 95677-2857

Dated: June 10, 2015

By: /s/ Angelina Caviles
Angelina Caviles